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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,274	07/31/2001	Guei-Yuan Lueh	42390P11423	5707

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John P. Ward
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

EXAMINER

NGUYEN BA, HOANG VU A

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/920,274	Applicant(s) LUEH, GUEI-YUAN	
	Examiner Hoang-Vu A Nguyen-Ba	Art Unit 2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-10 and 13-17 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 11, 12, 18 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the application filed July 31, 2001.
2. Claims 1-19 have been examined.

Drawings

3. The drawings are objected to because Figures 1, 2 and 5 should be designated by a legend such as – Prior Art – because only that which is old is illustrated. See MPEP § 608.02(g).

Correction is required.

Claim Objections

4. Claims 1, 8 and 15 are objected to because of the following informalities:
 - a. Claim 1: a colon – : – should be added after “comprising”
 - b. Claims 1 (line 8), 8 (line 9) and 15 (line 10): the terms – and to – should be added between “the source code block” and “access to the updated memory locations” to clarify the meaning of the limitation.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 5, 6, 7, 9, 12, 13, 14, 18 and 19 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 5 (lines 2-3), 12 (line 3) and 19 (line 2) recite the limitation "the untransformed source code block." There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "said plurality of instructions" at lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation "the optimizer" at line 1. There is insufficient antecedent basis for this limitation in the claim.

b. Claims 6, 7, 13 and 14 are rejected under 35 U.S.C. § 112, second paragraph because they contain the trademark or trade name "JAVA" and "Just-in-Time." Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a product from Sun Microsystems, Inc., of Palo Alto, California. Accordingly, the identification/description is indefinite.

Claim Rejections – 35 USC § 101

7. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 15-19 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

While the claims are in the technological arts, they are not limited to “a practical application of an abstract idea which produced a useful, concrete, and tangible result.” State Street Bank & Trust v. Signature Financial Group, Inc., 149 F.3d 1368, 1375 n. 9 (Fed. Cir. 1998).

Specifically, the claim 15 while reciting an apparatus comprising a processor, a memory coupled thereto (i.e., hardware components), an identifier, transformer and a compensator (i.e., software components) fails to indicate that the software components are stored on the memory and executed by the processor. As recited, claim 15 fails to indicate that these software components are tangibly embodied and executed by a piece of hardware and that their functions have practical applications which produce useful, concrete, and tangible results under the State Street Formulation.

On this basis, claims 15 and claims 16-19, which depend from claim 15, are rejected under 35 U.S.C. § 101.

Claim Rejections – 35 U.S.C. § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-3, 6-7, 8-10, 13-14 and 15-17 are rejected under 35 U.S.C. § 102(b) as being anticipated by Applicant Admitted Prior Art (AAPA).

Claims 1, 8 and 15

AAPA discloses at least:

identifying a source code block in source code (see Applicant's disclosure, section 0003);

transforming the source code block including transforming references to values stored in memory locations into references to corresponding values stored in registers associated with the memory locations (see Applicant's disclosure, section 0003); and

generating compensation native code to update each memory location with a value from an associated register to provide native code corresponding to a source code exception handler associated with the source code block, access to the updated memory locations (see Applicant's disclosure, sections 0003-0007).

Claims 2, 9 and 16

The rejection of base claims 1, 8 and 15 is incorporated. AAPA further discloses *generating exception-handling code to handle any exception not handled by the native code corresponding to existing source code exception handlers (see Applicant's disclosure, sections 0015-0019).*

Claims 3, 10 and 17

The rejection of base claims 1, 8 and 15 is incorporated. AAPA further discloses *wherein the compensation native code forms part of the native code corresponding to an exception handler* (see at least Applicant's disclosure, sections 0015-0016).

Claims 6 and 13

The rejection of base claims 1, 8 and 15 is incorporated. AAPA further discloses *wherein the source code is in the form of byte codes compiled by a JAVA compiler* (see at least Applicant's Figure 1, block 20 and related discussion in the specification).

Claims 7 and 14

The rejection of base claims 1, 8 and 15 is incorporated. AAPA further discloses the method of claim 1 being *performed by a Just-in-Time compiler* (see at least Applicant's Figure 1, block 18 and related discussion in the specification).

Allowable Subject Matter(s)

11. Claims 4, 5, 11, 12, 18 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

AAPA fails to disclose the following features when taken into combination with the remaining features of the base claim:

generating native code to initialize the registers; and generating register-initialization exception-handling native code to handle exceptions occurring during register initialization (claims 4, 11 and 18);

wherein the register-initialization exception-handling native code allows native code corresponding to the untransformed source code block to be executed if an error occurs during register initialization (claims 5, 12 and 19).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Antony Nguyen-Ba, whose telephone number is (703) 305-0103. The examiner can normally be reached on Tuesday - Friday from 6:15 – 3:45 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam, can be reached at (703) 305-4552.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Central Fax Number

(703) 872-9306



ANTONY NGUYEN-BA
PRIMARY EXAMINER

Art Unit 2122

June 22, 2004